



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,746	12/21/2005	Ralph L. Resnick	EH - 0148 US	8270

48740 7590 02/20/2007  
IP & INTERNET LAW NORTH, LLC  
P.O. BOX 38  
ZELIENOPLE, PA 16063

EXAMINER
----------

MASINICK, MICHAEL D

ART UNIT	PAPER NUMBER
----------	--------------

2125

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/561,746

Applicant(s)

RESNICK ET AL.

Examiner

Michael D. Masinick

Art Unit :

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-11 are pending in this application. This is the first office action on the merits. Claims 5 and 10 are identical claims. Claim 10 should be canceled in response to this office action.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The specification, in the “disclosure of invention” section contains several paragraphs reciting claim elements and further specific definitions thereof. While applicant acts as his or her own lexicographer, the additional defining of claim elements in the specification to this degree makes the claims themselves unclear. It is unclear whether applicant intends all claim elements noted in the specification to be considered part of the claims themselves. A response to this rejection must include an affirmation that all claim elements further defined in the specification are indeed claim elements to be included in the scope of the claims or further clarification. To further clarify the claims themselves, these definitions of the claim elements should be moved into the claims.

3. An example of this being problematic comes in page 3 of the specification which discusses the meaning of the term “holistically” and proceeds to give examples of the types of

Art Unit: 2125

procedures that are to be taken into account. It is unclear whether these examples are meant to be part of the claimed invention.

4. Claims 3, 4, 8 and 9 recites the limitation "the 3DP process" or "the SLS process".

There is insufficient antecedent basis for this limitation in the claim. Claim language should be modified to recite "a" process.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,305,769 to Thayer et al.

7. Referring to independent claims 1 and 6, Thayer shows a method comprising the steps of:

a) selecting an article or class of articles to be made (Column 6, lines 1-9), b) holistically designing the article or class of articles and the manufacturing process for making the article or class of articles, wherein the manufacturing process includes the use of a solid free-form fabrication process (Pages 1-3 of the specification); and c) capturing the resulting designs of the article or class of article and the manufacturing process (CAD Drawings).

8. Referring to claims 2 and 7, Thayer shows the step of making the article by the manufacturing process in accordance with the captured designs of the article and the manufacturing process (purpose of Thayer patent).
9. Referring to claims 3 and 8, Thayer shows wherein the solid free-form fabrication process is the 3DP process (Column 1).
10. Referring to claims 4 and 9, Thayer shows wherein the solid free-form fabrication process is the SLS process (Column 1).
11. Referring to claims 5, 10, and 11, Thayer shows wherein the step of capturing includes the use of at least one of the group consisting of electronic records, analog records, and manual writing (Cad Design – electronic record).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Masinick whose telephone number is (571) 272-3746. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2125

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'MDM', with a stylized flourish at the end.

Michael D Masinick  
Examiner  
Art Unit 2125

MDM, Feb. 7, 2007